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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,618	01/05/2001	Volker Zimmer	RDID004IUS	8239

32842 7590 06/19/2003

THE LAW OFFICE OF JILL L. WOODBURN, L.L.C.  
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128 SHORE DR.  
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EXAMINER
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IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 06/19/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/555,618

Applicant(s)

ZIMMER ET AL.

Examiner

Sikyin Ip

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-14 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-14, and 16-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 3-14 and 16-26 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 4759805 to Saruwatari et al (PTO-1449, col. 1, lines 43-51), FR 2100817 (PTO-1449, page 4, lines 21-30), USP 3730783 to Streel (PTO-1449, col. 2, lines 31-50), USP 3255035 to Clough (PTO-1449, col. 3, example 1), or AN 115:237352 in view of McGannon (The Making, Shaping and Treating of Steel, United States Steel).

4. The Saruwatari et al, FR 2100817, Streel, Clough, and AN 115:237352 reference(s) disclose(s) the features including the claimed steps of forming a metal layer then oxidize the layer with water/vapor/steam. The difference between the

Saruwatari et al, FR 2100817, Streel, Clough, and AN 115:237352 reference(s) and the claims are as follows: said references do not set forth to increase the surface tension of an object by the oxide coating and the coating substrate is an analytical test element. However, McGannon in Figures 12-109 to 12-114 disclose(s) the surface tensions Vs. oxides in the same field of endeavor. Therefore, as is evinced by Figures and teachings of McGannon that ordinary skill artisan would recognize oxides formed by cited references would affect surface tensions of the objects. Thus, the use of oxide to change surface tension of an object is contemplated within ambit of ordinary skill artisan as is evinced by references of record.

5. With respect to the claimed "analytical test element" limitation that it fails to define structure and/or properties of the coating substrate. Thus, it reads on the coating substrates of the cited references.

6. With respect to the instant claim 4, that cited references do not disclose the deposited layer is treated by superheated water vapour. But, it is well settled that the form of reactants (here boiling water, water vapor, steam, or superheated water) is believed mere a choice between well known forms of such substances. In the absence of evidence of some unobvious aspect of their selection, use of those substances would seem to add nothing of patentable significance to the instant claims. In re Austin, et al., 149 USPQ 685, 688.

7. Cited references except USP 4759805 (col. 3, lines 43-51) do not explicitly disclose the formed oxide coatings are more hydrophilic than the coating substrates. But, oxide coatings of cited references are formed by water/steam/vapor which evinces the formed oxide coatings are more hydrophilic/wettable than the coating substrates.
8. The claimed oxide layer is disclosed by AN 115:237352 in the abstract. Cited references appear silence about the deposited layer thickness. But, the instant specification does not have teaching to select the thickness (see page 13, first full paragraph of the instant specification). Thus, it is considered as non-critical or conventional.

*Response to Arguments*

9. Applicant's arguments filed April 2, 2003 have been fully considered but they are not persuasive.
10. Applicants argue that the limitation of using superheated water vapor as recited in claim 4 has not been disclosed by references of record. But, it is well settled that the form of reactants (here boiling water, water vapor, steam, or superheated water) is believed mere a choice between well known forms of such substances. In the absence of evidence of some unobvious aspect of their selection, use of those substances would seem to add nothing of patentable significance to the instant claims. In re Austin, et al., 149 USPQ 685, 688.

11. Applicants argue that none of the cited references discloses the claimed analytical test element. But, the claimed "analytical test element" limitation fails to define structure and/or properties of the coating substrate. Thus, it reads on the coating substrates of the cited references.

12. Applicants' argument with respect to McGannon is noted. But, McGannon is merely cited to show oxide layer/coating would inherently create tension on a substrate surface.

### *Conclusion*

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

### *Examiner Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

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**SIKYIN IP**  
**PRIMARY EXAMINER**  
**ART UNIT 1742**

**S. Ip**  
June 15, 2003